REMARKS

Claim Objections

Claim 5 is objected to because of an informality. Specifically, the phrase "characterized in that" has been replaced by the word "wherein." As noted by the Office Action, this represents only an informality. This amendment is made under 37 CFR §1.116(a) complying with a requirement of form. Accordingly, no showing of good and sufficient reason why the amendment was not earlier presented is necessary.

Claims 4 and 9-11 are objected to as being in improper form. Specifically, a multiple dependent claim cannot depend from another multiple dependent claim. 35 USC §112, fifth para. Applicants respectfully note Claims 3, 4, 9 and 11 were amended for compliance with 35 USC §112 and 37 CFR §1.75 by Preliminary Amendment dated Dec. 5, 2000 and received by the Patent Office on Dec. 20, 2000. A copy of the Preliminary Amendment and return postcard are enclosed for the Examiner's convenience. Given the amendments are made to bring the claims into compliance with the statutory and regulatory requirements, no further action is believed necessary. The Examiner is respectfully requested to examine these claims as previously presented.

Claim Rejections – 35 USC §112

Claims 1-12, 14-17 and 19 are rejected under 35 USC, first para., for failure to comply with the written description requirement. Particularly, the Office Action states Claims 1 and 16 recite a membrane being impermeable to gas and liquid, but do not find support in the specification. Instead, the Office Action believes support to be limited to a membrane coated with a soluble layer of PVA.

The essential question is whether or not the description allows persons of ordinary skill to recognize that the inventor actually invented what is claimed. MPEP 2163.02. The test for sufficiency is whether the disclosure reasonably conveys the inventor had possession of the claimed subject matter. *Id.* So as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire claim scope, the enablement requirement is satisfied. MPEP 2165.01(b). Simply by disclosing a device that performs a function or has a property, the application necessarily discloses that function or advantage, even though it says nothing explicit about it. MPEP 2163.07(a).

In this case, the Examiner's attention is respectfully directed to the specification at 10:15-27. Here, the specification discloses the k/d ratio and how material thickness is related to

permeability. The Examiner's attention is also respectfully directed to the specification at 10:29-11:5. Here, the specification discusses the relationship between evaporation of liquid from the pores and permeability. Finally, the Examiner's attention is directed to the specification at 8:30-9:4. Here, the specification discusses bulk materials which comprise soluble materials, such as polyvinyl alcohol and polyvinyl acetate. The specification further states that, upon contact with liquid, such as oil or water, the materials dissolve and create empty or expanded voids. Reading these portions of the specification, one of ordinary skill in the art (if not less) would understand how to create soluble membranes without undue experimentation. The law requires nothing more. The Examiner is respectfully requested to reconsider and withdraw this rejection.

Claim 15 is rejected because there is said to be insufficient support for the recitation that the membrane is permeable to both gas and liquid after activation. Without agreeing to the merits of the Examiner's position, Claim 15 is canceled hereunder to expedite prosecution on the merits.

Claim 16 is rejected for containing the language "a gas reservoir" and a membrane spanning the inlet so that gas passing through the inlet passes through the membrane. Of course, is it Hornbook law that *ipsis verbis* support is not required for a claim limitation. In this case, the Examiner's attention is respectfully directed to the specification at 2:25-27 and 3:11. Here, the specification states that 1) fluid passing through the inlet must pass across the membrane, and 2) that a fluid means liquid or gas. These two portions of the specification -- taken together -- recites that gas does pass through the membrane. Likewise, the Examiner's attention is directed to the specification at 3:18-20 discussing a membrane to seal the reservoir to prevent leakage of gas. While the term "gas reservoir" is not used *ipsis verbis*, one of ordinary skill reading this would understand that a reservoir for gas, i.e., a gas reservoir, is described. The Examiner is respectfully requested to consider the cited portions of the specification, in context, and to reconsider and withdraw the rejections under 35 USC §112.

Claim Rejections – 35 USC §103

Claims 1-3, 5, 12, 14, 16, 17 and 19 are rejected under 35 USC §103 over Talonn et al. (4,417,574) in view of Blackmer et al. (4,722,334) as evidenced by Rotman (4,734,372). Applicants respectfully note that Claim 1 recites a membrane which is gas impermeable and liquid impermeable. Upon activation, the liquid impermeable membrane becomes liquid permeable. Claim 16 recites a membrane which is also gas and liquid impermeable. However, upon dissolution of the soluble layer, this membrane becomes gas permeable.

In contrast, the membrane disclosed in Talonn is liquid permeable (1:63). Talonn fails to disclose the liquid impermeable membrane recited in Claim 16. Nor does Talonn disclose a liquid

impermeable membrane which becomes liquid impermeable as recited in Claim 1. Furthermore, Talonn only discloses gas permeability. Talonn fails to disclose the gas impermeability recited by Claims 1 and 16. Talonn does not lead one to the claimed invention.

Adding Rotman does not overcome the deficiencies found in Talonn. Rotman discloses a cell culturing apparatus wherein biopsy fragments are mixed in a medium for inoculation. Inside the cell compartment, membranes provide passageways for a nutrient medium to diffuse through the vessel (6:53-62). The basis stated in the Office Action for combining Rotman is that it permits vapor to diffuse therethrough.[1] However, the instant invention does not occur by diffusing a nutrient medium – but, instead, occurs and becomes better upon activation as recited in the claims.

The diffusion taught by Rotman does not accomplish this. Not only is there no suggestion to combine the references in the mosaic proposed by the Office Action, the combination fails to produce the reasonable expectation of success required to render obvious the claimed invention. MPEP 2143.02.

Further, adding Blackmer to the combination does not overcome the deficiencies of Talonn and Rotman. Blackmer teaches a porous membrane, but fails to teach a membrane which changes from impermeable to permeable upon activation. The three-way combination fails to yield the claimed invention, i.e., a reservoir having a membrane which changes permeability states upon activation. The Examiner is respectfully requested to reconsider and withdraw all rejections based upon the cited combination of the prior art.

Respectfully submitted,

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[1] Applicants do not admit that Rotman is either analogous art or properly combinable with the other two references. In order to rely upon a reference, the reference either must be in the Applicants' field of endeavor or reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a). Rotman teaches cell culturing, which is not within the Applicants' field of endeavor. Nor are Rotman's cell culturing and systems for performing cytotoxicity studies reasonably pertinent to the problem solved by the claimed invention – a reservoir having a membrane which changes state upon activation. However, the point is moot, since even adding Rotman to the combination fails to produce the claimed invention.